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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/840,063	04/24/97	AFILANI	2299-4

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MM41/0106

EXAMINER
VALONE, T

ART UNIT	PAPER NUMBER
2858	

DATE MAILED: 01/06/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/840,069

Applicant(s)
Afilani, Thomas

Examiner
Thomas Valone

Group Art Unit
2858



☒ Responsive to communication(s) filed on Oct 21, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-29 is/are pending in the application.

Of the above, claim(s) 1-21 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 22-29 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2,3

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Claims 1-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected species. Election was made **without** traverse in Paper No. 5.

Regarding generic claims, "a generic claim should include no material element additional to those recited in the species claims, and must comprehend within its confines the organization covered in each of the species" MPEP 806.04(d). Since none of the claims fulfill this requirement, none of them are deemed to be generic. This decision is made FINAL.

Priority

2. This application repeats a substantial portion of prior Application No. 08/758,248, filed 11-27-96, and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

Information Disclosure Statement

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information

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submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 22-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947).

a. The term "polarization" in claims 22, 27 is used by the claim to mean "electrical," while the accepted meaning is "optical." Especially in regards to filtering, it is not clear that only an electrical filter is implied, since polarized filters abound in the optics field, reading on claims 22 and 27.

b. The term "polarization pattern" in claims 22, 27 is used by the claim to mean "electrical" while the accepted meaning is "optical". It also seems that "polarization pattern" is

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used to mean "electrical charge" as well as "dielectric constant" in the same claim, which is indefinite.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 22-29, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mortenson of record, in view of Masuda and Lewinder.

As claimed, the polarization filter changing polarity is met by an optical phase shifting filter well known in the art. Furthermore, past decisions permit the PTO to give claim language its "broadest reasonable interpretation" during prosecution, citing *In re Zletz* 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989).

However, as best understood, Mortenson teaches the use of a porous metal salt material (p.2, line 75) which essentially is a dielectric (p.1, line 72) that he calls "half-conducting". Mortenson also refers to polarization potentials in claims 5-7. Mortenson specifically describes the concept referred to by the applicant as "replicate property matching material containing identical dielectric properties" (p. 8, line 21) where he teaches that ore-containing rocks can be utilized for

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the purpose of finding the ore in an electrostatic electrode (p.1, line 1). Thus Mortenson meets the applicant's "polarization pattern" of claims 22 and 27, even as disclosed in p. 8, line 5.

As to the limitation that the induced field be the opposite polarization pattern, this is interpreted to mean, in the standard language of the art to which this invention pertains, simply an electrical charge opposite to that of the entity detected. As indicated by Lewinder (Fig. 1), this is a standard effect to be expected in electrostatics charge induction, which always results in the opposite charge being induced in any object nearby.

As to the claims 23, 24, 28, 29, Masuda describes the process of impedance matching in electrostatic circuits which follows the line of thought introduced by Mortenson. The parallel plates of claim 29 are found in many capacitor sensors in this art, thus showing that the applicant actually presents a capacitor sensor, though not clearly described as such, which proposes to match impedance (which normally includes dielectric constant) with the object to be detected.

Regarding claims 25, 26, the use of a plastic polymer for the detection of plastic indicates the matching of dielectric impedance which is an obvious step based on the teachings of Mortenson and Masuda.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to use the teachings of Mortenson, with the capacitor sensor design well-known in the art to design a selective dielectric ("polarization") matching sensor ("filter") using Masuda's teachings, generating an opposite charge ("opposite

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polarization pattern”), with Lewiner’s disclosure, based on the dielectric constant (“polarization pattern”) of the entity to be detected.


Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The applicant's patent ^{ARI/ari '088} defines the apparatus in which the claimed filter is being used.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Valone whose telephone number is (703) 305-4912. The examiner can normally be reached on Monday through Friday from 9:30 AM to 6 PM.

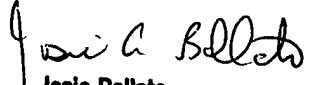
The fax phone number for this Group is (703) 308-7382.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4900.


Thomas Valone

Patent Examiner

December 30, 1998


Josie Ballato
Supervisory Patent Examiner
Technology Center 2800
12/31/98